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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,274	12/12/2000	L. Michael Maritzen	SON5180.02A	7901

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EXAMINER	
ELISCA, PIERRE E	

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/737,274	MARITZEN ET AL.	
	Examiner	Art Unit	
	Pierre E. Elisca	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/21/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office action is in response to Applicant's Response, filed on 5/17/2004.

2. Claims 1-23 are pending.

3. The rejection to claims 1-8, 11-20, and 23 under 35 U.S.C 103 (a) as being unpatentable over Johnson in view of Porterfield, and to claims 9, 10, and 21 under 35 U.S.C 103 (a) as being unpatentable over Johnson and Porterfield in view of Biffar as set forth in the Office action mailed on 2/17/2004 is maintained.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-8, 11-20, and 23 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Johnson (U.S. Pat. No. 6,529,885) in view of Porterfield et al. (U.S. Pat. No. 5,878,235).

As per claims 1, 5-8, 11-20 and 23 Johnson substantially discloses an inventive concept of carrying out electronic transactions including electronic drafts,

wherein payment on at least one of the drafts is contingent upon the removal of an associated contingency (which is equivalent to Applicant's claimed invention wherein it is stated that a system for performing electronic commerce transactions), comprising:

a transaction terminal configured to receive a user transaction device that coupled to the transaction terminal, said transaction terminal further configured to indicate that a transaction is to be performed (see., figs 1A and 1B, col 9, lines 5-67, col 10, lines 1-60);

a transaction privacy clearinghouse configured to communicate with the transaction device when a transaction is to be performed, said transaction privacy clearinghouse further configured for receipt of said device identifier and capable thereupon of authorizing a transaction on behalf of a user associated with said device identifier after the identity of said user has been verified (see., abstract, specifically wherein it is stated that parties and contingency approvers requesting access to the computer site are authenticated by encrypting identification information, and also Johnson does teach clearinghouses that form an integral part of negotiating a conventional paper check see., col 7, lines 26-64); and

an escrow account associated with the transaction privacy clearinghouse which is configured for receiving and dispersing forms of remuneration associated with authorized transactions (see., col 24, lines 43-67, col 25, lines 1-28). It is to be noted that Johnson fails to explicitly disclose a device identifier. However, Porterfield discloses a device identifier field 102 that identifies the status of each transaction (see., col 6, lines 14-29, lines 37-530. accordingly, it would have been obvious to a person of

ordinary skill in the art at the time the invention was made to modify the electronic transactions of Johnson by including the limitation detailed above as taught by Porterfield because this would ensure that electronic transaction is properly secured.

As per claims 2, 3, 4, and 22 Johnson discloses the claimed limitations of executing unit configured to automatically perform a transaction upon receiving a selected invoice or bill from a vendor that meets certain predetermined verification criterion (see., col 3, lines 9-29, specifically wherein it is stated that make payment or bill as the contingencies are met).

6. Claims 9, 10, and 21 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Johnson and Porterfield in view of Biffar (U.S.Pat. No. 6,047,269).

As per claims 9, 10, and 21 Johnson and Porterfield disclose the claimed limitations as stated in claims 8, 6 and 1 above. It is to be noted that Johnson and Porterfield fail to explicitly disclose an incentive unit or coupon, digital currency. However Biffar discloses a self-contained payment which includes a voucher at a time of transaction such as coupons (see., col 5, lines 23-27). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Johnson and Porterfield by including the incentive process taught by Biffar because such modification would provide the electronic transactions of

Johnson with the enhanced capability of creating digital coupons or voucher or incentive which will facilitate a fast electronic transaction.

RESPONSE TO ARGUMENTS

7. Applicant's arguments filed on 05/17/2004 have been fully considered but they are not persuasive.

REMARKS

8. In response to Applicant's arguments, Applicant argues that:

a. " the Examiner has not established a prima facie case of obviousness with respect to claims 1, 11 and 15". The Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071,5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Eli Lilli & Co., 902 F.2d 943, 14 USPQ2d

1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In re Nilssen, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App & Inter); and Es parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to Ex parte Levengood, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, In re Keller, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. In re Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

b. "a transaction terminal, a transaction privacy clearinghouse, and an escrow account". Based upon foregoing rejection detailed above, it is believed that Johnson discloses this limitation in figs 1A and 1B, col 9, lines 5-67, col 10, lines 1-60, abstract, specifically wherein it is stated that parties and contingency approvers requesting access to the computer site are authenticated by encrypting identification information, and also Johnson does teach clearinghouses that form an integral part of negotiating a conventional paper check see., col 7, lines 26-64, and col 24, lines 43-67, col 25, lines 1-28.

c " maintaining within a secure server an electronic escrow account in association with the user". As indicated above, Johnson discloses this limitation in col 24, lines 43-67, col 25, lines 1-28, specifically wherein said the escrow agent may then remove the first contingency (buyer payment or user payment) after checking with the buyer's home bank (or user's home bank or user's escrow account) and securing the funds needed to pay see., abstract for secure computer or secure server site accessible only by authenticated parties to the transaction and by any authenticated contingency approver, figs 1A-2 and figs 5-7.

d. In response to claims 2, 3, 4, and 22, Applicant argues that Johnson fails to disclose: "executing unit configured to automatically perform a transaction upon receiving a selected invoice or bill from a vendor that meets certain predetermined verification. However, the Examiner respectfully disagrees since Johnson discloses this limitation in col 3, lines 9-29, specifically wherein it is stated that make payment or bill as the contingencies are met.

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pierre Eddy Elisca

Primary Patent Examiner

July 28, 2004